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July 27, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: **Application Serial No.:** 09/683,943
Confirmation No.: 5493
Filing Date: March 5, 2002
Applicants: Parmelee, et al
Title: Automated Transaction Machine Digital
Signature System And Method
Docket No.: D-1154 R2

Sir:

In Response to the Examiner's Answer dated June 1, 2007, please find enclosed a Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-referenced application.

Very truly yours,

Ralph E. Jocke Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

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D-1154 R2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	
Parmelee, et al.)	
)	Art Unit 2137
Serial No.: 09/683,943)	
)	
Confirm. No.: 5493)	
)	
Filed: March 5, 2002)	Patent Examiner
)	Nadia Khoshnoodi
For: Automated Transaction Machine)	
Digital Signature System And)	
Method)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated June 1, 2007.

STATUS OF CLAIMS

Claims 1-41 are pending in the Application.

Claims rejected: 1-41

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-41. These claim rejections were the only claim rejections present in the Office Action ("Action") dated April 26, 2006. Claims 1-41 have been at least twice rejected.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-6, 8-11, 15-16, 19, 27-30, 33-39, and 41 are obvious under 35 U.S.C. § 103(a) over Wheeler, et al., U.S. Publication No. 2002/0026575 ("the Wheeler Publication") in view of Cohen, WO 00/55793 ("Cohen");

Whether Appellants' claims 7, 12-14, and 40 are obvious under 35 U.S.C. § 103(a) over the Wheeler Publication in view of Cohen as applied to claims 1 and 11 and further in view of Randle, et al., U.S. Patent No. 5,974,146 ("Randle");

Whether Appellants' claims 17 and 18 are obvious under 35 U.S.C. § 103(a) over the Wheeler Publication in view of Cohen as applied to claim 1 and further in view of Meurer, U.S. Publication No. 2004/0215566 ("the Meurer Publication");

Whether Appellants' claims 20-21, 23, 25-26, and 31-32 are obvious under 35 U.S.C. § 103(a) over the Wheeler Publication;

Whether Appellants' claim 22 is obvious under 35 U.S.C. § 103(a) over the Wheeler Publication in view of Cohen as applied to claim 20 and further in view of Randle; and

Whether Appellants' claim 24 is obvious under 35 U.S.C. § 103(a) over the Wheeler Publication as applied to claim 20 and further in view of the Meurer Publication.

ARGUMENT

The Answer includes a "(9) Grounds of Rejection" section beginning on page 3. All of the grounds of rejection included in this section of the Answer appear to substantially correspond to the arguments and rejections previously presented in the Office Action dated April 26, 2006. Appellants' Supplemental Appeal Brief filed on January 17, 2007 is incorporated herein by reference.

Appellants respectfully submit these specific arguments and rejections have been addressed in Appellants' Supplemental Appeal Brief filed on January 17, 2007, in which Appellants have shown that all rejections should be reversed. Therefore please also refer to Appellants' previous arguments in Appellants' Supplemental Appeal Brief which is hereby incorporated herein by reference.

In addition, the following arguments specifically reply to the new assertions made in the Answer. However, even though the present reply has been organized in a manner which addresses issues and arguments as newly presented in the Answer, Appellants do not waive their right to have all of their claims, each of which was separately argued in the Appeal Brief, considered independently of each other by the Board. If the Board has an unwritten policy which considers the format of the present Reply Brief to be a waiver of Appellants' right to have each separately argued claim in the Appeal Brief be independently considered by the Board, then Appellants respectfully request that the Board so notify Appellants and provide an opportunity for Appellants to submit a revised Reply Brief.

Response to Arguments in Examiner's Answer

Beginning at the bottom of page 6 of the Examiner's Answer, there is a section labeled **"(10) Response to Arguments"** which presents additional arguments in response to Appellants' Appeal Brief. Appellants respectfully submit that these additional arguments do not overcome the numerous deficiencies in the rejections pointed out in Appellants' Appeal Brief. The Examiner has again failed to establish that each of the recited elements, features, relationships, and steps pointed out in the Appeal Brief as missing in the applied art, can be found in the prior art. The Examiner has not established anticipation or *prima facie* obviousness based on the applied art. Therefore it is respectfully submitted that all of the rejections of claims 1-41 should be reversed.

Regarding the Effective Filing date of the Wheeler Publication

The rejections of the claims are based on subject matter referenced in U.S. Publication No. 2002/0026575 ("the Wheeler Publication") which does not qualify as prior art. As discussed in the Appeal Brief, the Wheeler Publication was filed as an application on August 6, 2001, which filing date is after the effective filing date of Appellants' earliest provisional (U.S. Application No. 60/273,996 filed of March 7, 2001).

The Answer, at pages 26-45, attempts to show where each of the referenced paragraphs in the Wheeler Publication is supported by the Wheeler Provisional (U.S. Application No. 60/223,076). Also, the Answer, at pages 45-102, attempts to show where specifically recited features (argued in Appellants' Appeal Brief) are found in the Wheeler Publication. However,

nowhere does the Answer attempt to directly show where each of these specifically recited features is found in the Wheeler Provisional.

As discussed previously, the Wheeler Publication is not prior art. The Answer introduces confusion by also discussing the Wheeler Provisional and the Wheeler Patent (6,820,202). However, the Wheeler Provisional and the Wheeler Patent are not the same as the Wheeler Publication. Nowhere does the Answer show that the recited features pointed out by Appellants as missing in the prior art, are in fact shown by either the Wheeler Provisional or the Wheeler Patent.

Instead of specifically showing where the Wheeler Provisional specifically teaches the features recited in Appellants' claims, the Answer relies on referencing features of the non-prior art Wheeler Publication in the rejection, and then asserting that portions of the non-prior art Wheeler Publication are supported by the earlier Wheeler Provisional. Such a two-step analysis could only be appropriate if the Wheeler Publication and Provisional had corresponding disclosures. However, this is not the case. The Wheeler Provisional is a haphazard collection of facts and features which are independently described with no reasonable description of how the different facts and features are related. As such, the Wheeler Provisional does not provide anything close to a teaching or suggestion (or an enabling disclosure) with respect to the specific features and relationships recited in Appellants' claims.

The fact that the Wheeler Provisional does not teach Appellants' claimed features is established by the Examiner's citation to the non prior art Wheeler Publication. If the Wheeler Provisional actually taught what the Examiner contends, then there is no need for the Examiner to rely on the Wheeler Publication. The fact that the Examiner cites to the non-prior art Wheeler

Publication constitutes a clear admission that the teachings of the Wheeler Provisional are not sufficient to reject Appellants' claims.

Although portions of the Wheeler Provisional may support some limited aspects of the referenced portions of the Wheeler Publication, such portions of the Wheeler Provisional do not show all of Appellants' claimed features and relationships. The Wheeler Provisional does not include the material disclosure of the Wheeler Publication that was relied on by the Examiner in rejecting Appellants' claims. The additional material in the Wheeler Publication not found in the Wheeler Provisional is not prior art and can not be used as a basis to reject the claims.

Because the Answer has failed to specifically and directly establish that the Wheeler Provisional shows each and every feature and relationship recited in Appellants' claims that was relied on to support the rejections, the Answer has failed to establish *prima facie* obviousness. On this basis all of the rejections of claims 1-41 should be reversed.

The following shows examples of the specific features and relationships recited in Appellants' claims that are missing from the portions of the Wheeler Provisional indirectly referenced by the Answer with respect to these claims.

Claim 1

With respect to claim 1, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **[T]he computer processor is operative to communicate with a plurality of ATMs.**

- **[T]he computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital safe deposit accounts.**

The Answer appears to have indirectly referenced page 6 of the "rachip" portion, pages 3, 5-6 of the "aads" portion, and/or pages 5-6 of the "aadsstraw" of the Wheeler Provisional with respect to this subject matter in claim 1. Page 6 of the "rachip" portion discusses a public key registered in a database. Pages 3, 5-6 of the "aads" portion discusses upgrading transactions to a public key paradigm. Page 6 of the "aadsstraw" portion discusses an account in a message. However, without the benefit of impermissible hindsight and the specific teachings of Appellants' disclosure, such unconnected features discussed in the Wheeler Provisional do not provide an enabling structure, or any disclosure or suggestion to produce Appellants' claimed subject matter.

Nowhere do these portions of the Wheeler Provisional disclose or suggest a computer processor operative to communicate with a plurality of ATMs, which computer processor is responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document using a private key associated with an account. In addition as discussed in the Appeal Brief, Cohen also does not disclose or suggest these features.

Because the Answer has failed to specifically and directly establish that any prior art shows all of the features and relationships recited in claim 1, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 1 should be reversed.

Claim 2

With respect to claim 2, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **[T]he computer processor is operative to receive the electronic document from the at least one ATM.**
- **[T]he computer processor is operative to store the electronic document in the data store in association with the one digital safe deposit account.**

The Answer appears to have indirectly referenced pages 3-6 of the "aadsstraw" portion of the Wheeler Provisional with respect to this claim. Page 6 of this portion of the Wheeler Provisional includes the statement that: "For an AADS employee building access infrastructure, the badge reader needs to create a unique message (to be signed) for each operation". Also, page 5 of this portion the Wheeler Provisional includes the statement that: "an audit trail binding the public/private key pair to a specific card at a known assurance level, as well as to some entity that the card has been issued to." However, nowhere does the Wheeler Provisional disclose that the audit trail ever involves storing the unique message. Such an audit trail could simply store an historical log.

Nowhere does the prior art disclose or suggest storing an electronic document received from an ATM in a data store in association with an account associated with the private key used to sign the electronic document.

Because the Answer has failed to specifically and directly establish that the prior art shows all of the features and relationships recited in claim 2, the Answer has failed to establish

prima facie obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 2 should be reversed.

Claim 4

With respect to claim 4, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **[T]he computer processor is operative to encrypt and decrypt the electronic document stored in the at least one data store responsive to a secret key received from the at least one ATM.**

The Answer appears to have indirectly referenced page 6 of the "aads " portion and pages 1 and 6 of the "aadsstraw" portion the Wheeler Provisional with respect to this claim. Each of these portions of the Wheeler Provisional discusses digital signatures. However, nowhere do these portions of the Wheeler Provisional disclose or suggest that a computer processor is operative to encrypt and decrypt an electronic document stored in a data store responsive to a secret key received from an ATM.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 4, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 4 should be reversed.

Claim 5

With respect to claim 5, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited feature:

- **[T]he computer processor is operative to access the private key associated with the one digital safe deposit account responsive to a message received from the at least one ATM which includes a financial account number that corresponds to the financial account number associated with the one digital safe deposit account.**

The Answer appears to have indirectly referenced pages 1 and 6 of the "aadsstraw" portion and pages 1-2 of the "aadsbrnd" portion of the Wheeler Provisional with respect to this claim. Each of these portions of the Wheeler Provisional discusses digital signatures. However, nowhere do these portions of the Wheeler Provisional disclose or suggest a computer processor that is operative to access a private key associated with an account, responsive to a message received from an ATM. Further, nowhere do these portions of the Wheeler Provisional disclose or suggest that the computer processor is operative to access the private key associated with the account responsive to a message received from the at least one ATM, which message includes a financial account number that corresponds to the financial account number associated with the account.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 5, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 5 should be reversed.

Claim 6

With respect to claim 6, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited feature:

- **[T]he at least one financial account number corresponds to a credit card number.**

The Answer appears to have indirectly referenced page 3 of the "aads" portion of the Wheeler Provisional with respect to this claim. This portion of the Wheeler Provisional discloses that a credit card transaction could be updated to include a "public key paradigm". However, nowhere does the Wheeler Provisional disclose or suggest a computer processor that is operative to access a private key associated with an account responsive to a message received from an ATM, which message includes a credit card number that corresponds to the financial account number associated with the account.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 6, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 6 should be reversed.

Claim 15

With respect to claim 15, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **[T]he computer processor is operative to receive a one-way hash of the electronic document from the at least one ATM.**

The Answer appears to have indirectly referenced page 1 of the "aadsstraw" portion of the Wheeler Provisional with respect to this subject matter. This portion of the Wheeler Provisional discloses computation of a secure hash of a message. However, nowhere does the

Wheeler Provisional disclose or suggest a computer processor that is operative to receive a one-way hash of an electronic document from an ATM.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 15, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 15 should be reversed.

Claim 20

With respect to claim 20, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **receiving a financial account number from an automated transaction machine;**
- **accessing a private key associated with the financial account number; and**
- **enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key**

The Answer appears to have indirectly referenced pages 1-6 of the "aadsstraw" portion of the Wheeler Provisional with respect to this subject matter. Page 6 of this portion of the Wheeler Provisional discusses an account in a message. However, nowhere does this portion of the Wheeler Provisional disclose or suggest accessing a private key associated with a financial account number received from an automated transaction machine. Further, nowhere does this portion of the Wheeler Provisional disclose or suggest enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 20, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 20 should be reversed.

Claim 23

With respect to claim 23, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **storing a digitally signed copy of the electronic document in a digital safe deposit account in association with the financial account number**

The Answer appears to have indirectly referenced pages 3-6 of the "aadsstraw portion of the Wheeler Provisional with respect to this claim. Although an "audit trail" is discussed in this portion of the Wheeler Provisional, an audit trail could merely include an historical log. Nowhere does the Wheeler Provisional disclose or suggest storing a digitally signed copy of an electronic document in an account in association with a financial account number.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 23, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 23 should be reversed.

Claim 27

With respect to claim 27, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **receiving a request from an automated transaction machine to digitally sign an electronic document visually displayed by the automated transaction machine, wherein the request includes an account number that is associated with a digital safe deposit account**
- **accessing a private key associated with the digital safe deposit account responsive to the account number**
- **producing a digital signature for the electronic document responsive to the private key**

The Answer appears to have indirectly referenced pages 1 and 4-6 of the "aadsstraw" portion and pages 1-2 of the "aadsbrnd" portion of the Wheeler Provisional with respect to this subject matter. Each of these portions of the Wheeler Provisional discusses digital signatures. However, nowhere do these portions of the Wheeler Provisional disclose or suggest receiving a request from an automated transaction machine to digitally sign an electronic document visually displayed by the automated transaction machine. Further, nowhere does the Wheeler Provisional disclose or suggest accessing a private key associated with an account number included with the received request, for use with producing a digital signature for the document.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 27, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 27 should be reversed.

Claim 28

With respect to claim 28, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **storing a digitally signed copy of the electronic document in a data store in association with the digital safe deposit account**

The Answer appears to have indirectly referenced pages 3-6 and 13 of the "aadsstraw" portion of the Wheeler Provisional with respect to this claim. Although an "audit trail" is discussed in these portions of the Wheeler Provisional, an audit trail could merely include an historical log. Nowhere does the Wheeler Provisional disclose or suggest storing a digitally signed copy of an electronic document in a data store (or in an audit trail) in association with a digital safe deposit account (or any other account).

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 28, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 28 should be reversed.

Claim 31

With respect to claim 31, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **receiving a request at an ATM to digitally sign an electronic document visually displayed by the ATM;**
- **causing a digital signature and a digital time stamp to be produced for the electronic document; and**

- **causing the digital signature and the digital time stamp to be attached to the electronic document**

The Answer appears to have indirectly referenced pages 1, 4-6 and 12-13 of the "aadsstraw" portion and pages 1-2 of the "aadsbrnd" portion of the Wheeler Provisional with respect to this subject matter. Each of these portions of the Wheeler Provisional discusses digital signatures. However, nowhere do these portions of the Wheeler Provisional disclose or suggest receiving a request at an ATM to digitally sign an electronic document visually displayed by the ATM.

Page 6 of the "aadsstraw" portion of the Wheeler Publication discusses a unique message that includes a "data/time". However, nowhere does the Wheeler Provisional disclose or suggest causing a "digital time stamp" to be produced and attached to an electronic document. In addition, nowhere does the Wheeler Provisional disclose or suggest producing both a digital signature and a digital time stamp for an electronic document, and attaching the digital signature and the digital time stamp to the electronic document.

Because the Answer has failed to specifically and directly establish where the prior art shows all of the features and relationships recited in claim 31, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 31 should be reversed.

Claim 33

With respect to claim 33, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **responsive to the data associated with the financial account received in (a), causing through operation of the at least one server, a private key which corresponds to the data associated with the financial account received in (a) to be accessed from at least one data store in operative connection with the at least one server, wherein the private key was previously stored in the at least one data store in correlated relation with the data associated with the financial account;**
- **causing through operation of the at least one server, the digital signature to be attached to the electronic document during or after the display of the electronic document through a display device viewable by a customer associated with the financial account**

The Answer appears to have indirectly referenced page 6 of the "aads" portion, pages 1 and 6 of the "aadsstraw" portion, and pages 1-2 of the "aadsbrnd" portion of the Wheeler Provisional with respect to this subject matter. Although these portions of the Wheeler Publication disclose digital signatures, nowhere does the Wheeler Provisional disclose or suggest a server that causes a private key to be accessed from a data store responsive to data associated with a financial account received by the server. In addition, nowhere does the Wheeler Provisional disclose or suggest a server that causes a digital signature produced responsive to the private key to be attached to an electronic document during or after the display of the electronic document through a display device viewable by a customer associated with the financial account.

Because the Answer has failed to specifically and directly establish that the prior art shows all of the features and relationships recited in claim 33, the Answer has failed to establish

prima facie obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 33 should be reversed.

Claim 38

With respect to claim 38, nowhere does the Wheeler Provisional (or Cohen) disclose or suggest the recited features:

- **causing through operation of the at least one server the electronic document to be stored in the at least one data store in correlated relation with the data associated with the financial account received in (a)**


The Answer appears to have indirectly referenced pages 3-6 and 13 of the "aadsstraw" portion of the Wheeler Provisional with respect to this claim. Although an "audit trail" is discussed in these portions of the Wheeler Provisional, an audit trail could merely include an historical log. Nowhere does the Wheeler Provisional disclose or suggest a server that causes an electronic document to be stored in a data store in correlated relation with data associated with a financial account.

Because the Answer has failed to specifically and directly establish that the prior art shows all of the features and relationships recited in claim 38, the Answer has failed to establish *prima facie* obviousness. On this basis and for the reasons discussed in the Appeal Brief, the rejection of claim 38 should be reversed.

CONCLUSION

Each of Appellants' pending claims specifically recites elements, features, relationships, and steps that are neither disclosed nor suggested in the prior art. The Office has not established *prima facie* obviousness with respect to any of the claims. For these reasons, it is respectfully submitted that all of the rejections should be reversed.

Respectfully submitted,



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